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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/607,922	06/27/2003	Ravindra K. Pandey	25886-0094	8140

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EXAMINER

NWAONICHA, CHUKWUMA O

ART UNIT PAPER NUMBER

1621

DATE MAILED: 05/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/607,922

Applicant(s)

PANDEY ET AL.

Examiner

Chukwuma O. Nwaonicha

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 07 February 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 5,8-23 and 122-124 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 5, 8 and 10 is/are rejected.
- 7) ☒ Claim(s) 9-23 and 122-124 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)                                    | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

114

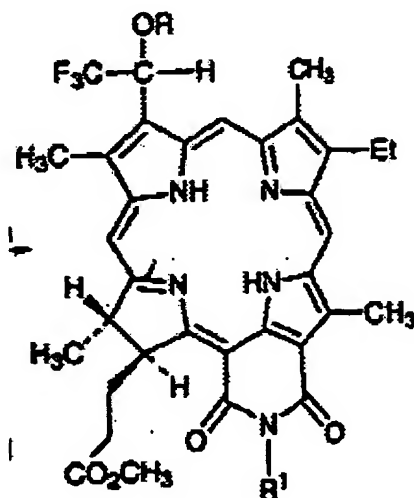
**DETAILED ACTION*****Current Status***

1. This action is responsive to Applicants' amendment of 13 December 2004.
2. Receipt and entry of Applicants' amendment is acknowledged.
3. Claims 5, 8, 9-23 and 122-124 are pending.
4. The objection of claims 9-23 and 122-124 is maintained.
5. The rejection under 35 U.S.C 102(b), as being anticipated by Li et al. is maintained.

**Claim 8** is rejected under 35 U.S.C. 102(b) as being anticipated by Li et al.

Li et al. disclose applicants' claimed compound. See page 1786, compounds 8 and 18b

Applicants' amendment filed 13 December 2004 have been fully considered but they are not persuasive because Li et al. compound reads on applicants' claimed invention. The claimed compound is anticipated by Li et al. when R is hydrogen and R<sup>1</sup> is n-hexyl. See page 1786, compounds 8 and 18b.



***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

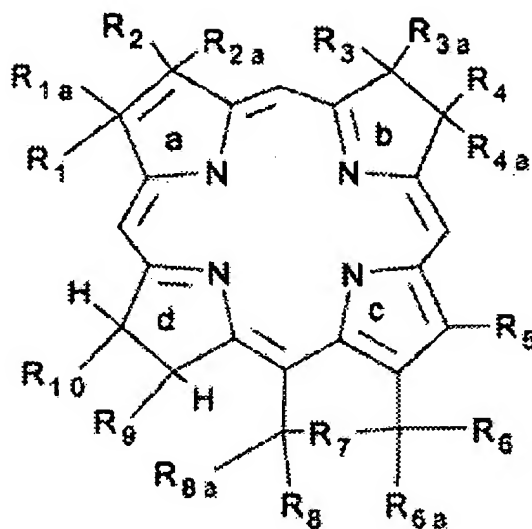
(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

**Claims 5, 8, 9 and 10** are rejected under 35 U.S.C. 103(a) as being unpatentable over Pandey et al., {US 5,952,366} in view of Li et al. (Application for Ruppert's Reagent in Preparing Novel Perfluorinated Porphyrins, Chlorins and Bacteriochlorins, J. Chem. Soc., Perkin Trans. 1, 1999, 1785-1787).

Applicants claim a compound of the general formula 1; wherein all the variables are as defined.



formula 1

**Determination of the scope and content of the prior art (M.P.E.P. §2141.01)**

Pandey et al. teach a compound of general formula 2;

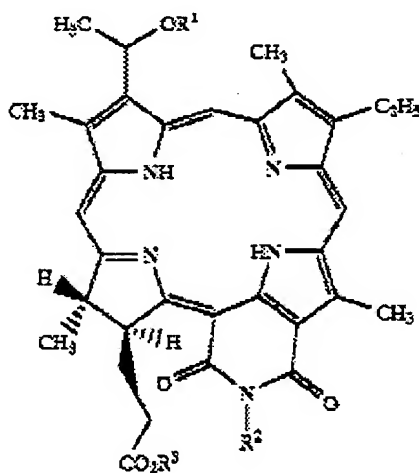


figure 2

wherein R<sup>1</sup> and R<sup>2</sup> are alkyl, which is substituted with halogen. See column 3, lines 19-25.

**Ascertainment of the difference between the prior art and the claims (M.P.E.P. §2141.02)**

Pandey et al. compounds differ from the instantly claimed compounds in that Pandey et al. teach a compound wherein R<sup>1</sup> and R<sup>2</sup> are alkyl group while applicants claim a compound wherein R<sup>1</sup> and R<sup>2</sup> are alkyl group which is substituted with a fluorine atom or 3,5-bis(trifluoromethyl)benzyl group. However, Li et al. teach a compound wherein R<sup>1</sup> is an alkyl group, which is substituted with a fluorine atom.

**Finding of prima facie obviousness—rational and motivation (M.P.E.P. §2142-2143)**

The instantly claimed compound would have been suggested to one of ordinary skill because one of ordinary skill in the art would have a reasonable expectation of success in practicing the instant invention since Pandey et al. and Li et al. specifically teach that a compound of general formula 2 wherein R<sup>1</sup> and R<sup>2</sup> are alkyl, which is substituted with halogen is used for pharmaceutical applications. Said person would have been motivated to practice the teaching of Pandey et al. and Li et al. by selecting a compound wherein R<sup>1</sup> is an alkyl group, which is substituted with a fluorine atom used for the detection or treatment of hyperproliferative tissue. The instantly claimed invention would therefore have been suggested to one of ordinary skill in the art.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 5 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 5 is indefinite because the variable R and R' are not defined in the claim.

Claim 5 is indefinite because the nitrogen in the general formula in claim 5 has two bonds instead of three. See rings a and c of the general formula.

Claim 10 is rejected because it is not clear if it is cancelled or active.

Corrections are required.

**No claim is allowed.**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chukwuma O. Nwaonicha whose telephone number is 571-272-2908. The examiner can normally be reached on Monday thru Friday, 8:30am to 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann R. Richter can be reached on 571-272-0646. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

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you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Chukwuma O. Nwaonicha, Ph.D.  
Patent Examiner  
Art Unit: 1621  
December 6, 2004.



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Technology Center 1600